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10/625,909	07/24/2003	Marco Stura	59643.00294	1209

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EXAMINER

RAMOS FELICIANO, ELISEO

ART UNIT PAPER NUMBER

2687

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/625,909	Applicant(s) STURA ET AL.	
	Examiner Eliseo Ramos-Feliciano	Art Unit 2687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-32 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings were received on November 4, 2005. These drawings are acceptable.

Requirement for Information

2. The reply is deemed complete.

Claim Objections

3. Previous objection to claim 15 is withdrawn in view of Applicant's amendment filed November 4, 2005.

Claim Rejections - 35 USC § 112 – 2nd paragraph

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 25-28 and 31-32** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **claims 25-26 and 31-32**, the full claim appear to be the preamble leaving no body with active limitations. No clear distinction between the preamble and the body of the claim. For examination on the merits the claim(s) will be interpreted as best understood.

As to **claims 27-28**, they depend from claims 25-26; therefore, they contain same problem explained above. For examination on the merits the claim(s) will be interpreted as best understood.

Claim Rejections - 35 USC § 112 – 1st paragraph

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. **Claims 25-26 and 31-32** are rejected under 35 U.S.C. 112, first paragraph, because they constitute single means claims, in view of rejection above. See MPEP 2164.08(a).

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 29-30** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed computer program product is non-statutory subject matter since it is not a process, machine, manufacture nor composition of matter; nor it is recorded on some computer-readable medium, see MPEP 2106(IV)(B)(1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1-6 and 8-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gemmer (US Patent Application Publication 2004/0022233 A1) in view of the Admitted Prior Art (in general paragraphs 0002-0015 of the present disclosure under the Background of the Invention; in particular as cited below).

Regarding **claim 1**, Gemmer teaches a telecommunications terminal that is part of a telecommunications system (paragraphs 0001-0002). Gemmer further teaches ISDN and Centrex networks (paragraphs 0003 and 0016-0020) of which the telecommunications terminal and/or the telecommunications system can be part of. Therefore, Gemmer discloses user equipment associated with a first access network and a second network. Because the claimed language does not require the first access network to be different from the second network nor exclusive, Gemmer's telecommunications system and ISDN or Centrex networks interchangeably read on the claimed language as claimed.

Gemmer discloses a method (e.g. page 2, right column) for supporting a communication session (e.g. call) of user equipment associated with a first access network, by a communication system (SYS) comprising at least one entity between said user equipment and a node with which the user equipment is arranged to establish a session via a second network, the method comprising the steps of:

a) establishing said session (call) between the user equipment (A or TEA) and the node (B or TEB) via said at least one entity (VER) ("the first connection (A) is actively engaged in a call to a second connection (B)" – page 2, claim 1, lines 5-7);

b) putting the session on hold ("the connection to the second connection (B) and the call arriving at the first connection (A) are held" – page 2, claim 1, lines 7-8; also page 1, paragraph 0003, lines 11-12);

c) reserving resources for said session while said session is on hold (resources are reserved because the connection with B is held by the switching center VER while a connection between A and C progresses) ("In order to make it possible to resume the connection to the

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connection B at some later time, this connection can be held by the switching center VER.” – page 2, paragraph 0021, lines 8-10); and

d) resuming said session with a message (“the call connection which was placed on hold between the first connection and the second connection (B) can be picked up once again” – page 2, claim 1, lines 14-16; also page 1, paragraph 0003, lines 15-16); and distributing charging information (page 1, paragraph 0003, line 17; page 2, paragraph 0020, line 8).

Gemmer further suggests that the system can be GSM (page 2, paragraph 0019, line 5). Nevertheless, Gemmer fails to specifically disclose that the message distributes an access network charging identifier (for charging purposes) as defined by applicant.

The prior art admitted by applicant (simply “Admitted Prior Art”) disclosed on page 4, paragraph 0013 of the present disclosure under the Background of the Invention section and paragraphs 0039-0040 teaches that GPRS (a particular GSM service) typically requires a GGSN entity, a P-CSCF (PDF) entity, a GPRS charging identifier (GCID) sent from the GGSN to the P-CSCF (PDF) typically using COPS to enable charging. GPRS is a particular GSM service. GSM is 3G. Therefore, combinable with Gemmer’s teachings given that Gemmer teaches that the system can be GSM (page 2, paragraph 0019, line 5 of Gemmer).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enable Gemmer’s invention with a charging identifier or vector as required by GPRS because GPRS is a particular GSM service and Gemmer teaches that the system can be GSM; therefore, these would be particular requirement of a particular system as choice of engineering design.

Regarding **claim 2**, Gemmer discloses everything as applied above (see *claim 1*).

Gemmer further suggests that the system can be GSM (page 2, paragraph 0019, line 5).

Nevertheless, Gemmer fails to specifically disclose determining if charging information is provided during the establishment of said session and carrying out steps b) to d) only when it has been determined that the charging information has not been provided.

The prior art admitted by applicant (simply "Admitted Prior Art") disclosed on page 5, paragraph 0015 of the present disclosure under the Background of the Invention section teaches that release 6 for third generation standard (3G) typically requires charging information not to be provided for a communication session. Consequently, there is no need to distribute charging information because it is not provided under 3G release 6. It should be noted that GSM is 3G. For that reason, Gemmer's invention would be constructively enhanced and would positively benefit from 3G release 6 requirements.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determining if charging information is provided during the establishment of said session and carrying out steps b) to d) only when it has been determined that the charging information has not been provided in Gemmer in order to comply with release 6 for third generation standard as Gemmer's invention would be constructively enhanced and would positively benefit from 3G release 6 requirements.

Regarding **claim 3**, Gemmer teaches a telecommunications terminal that is part of a telecommunications system (paragraphs 0001-0002). Gemmer further teaches ISDN and Centrex networks (paragraphs 0003 and 0016-0020) of which the telecommunications terminal and/or the telecommunications system can be part of. Therefore, Gemmer discloses user equipment associated with a first access network and a second network. Because the claimed language does not require the first access network to be different from the second network nor exclusive,

Gemmer's telecommunications system and ISDN or Centrex networks interchangeably read on the claimed language as claimed.

Gemmer discloses a method (e.g. page 2, right column) for supporting a communication session (e.g. call) of user equipment associated with a first access network, by means of a communication system (SYS) comprising at least one entity between said user equipment and a node with which the user equipment is arranged to establish a session via a second network, the method comprising the steps of:

a) modifying an existing session (call) between the user equipment and the node via said at least one entity (the existing session/call is modified in the sense it is interrupted; then placed on hold) ("interrupting the existing connection" "while the first connection (A) is actively engaged in a call to a second connection (B)" – page 1, paragraph 0003, lines 9-10; page 2, claim 1, lines 5-7);

b) putting the session on hold ("the connection to the second connection (B) and the call arriving at the first connection (A) are held" – page 2, claim 1, lines 7-8; also page 1, paragraph 0003, lines 11-12);

c) reserving resources for the modified session while said session is on hold (resources are reserved because the connection with B is held by the switching center VER while a connection between A and C progresses) ("In order to make it possible to resume the connection to the connection B at some later time, this connection can be held by the switching center VER." – page 2, paragraph 0021, lines 8-10); and

d) resuming said session with a message ("the call connection which was placed on hold between the first connection and the second connection (B) can be picked up once again" – page

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2, claim 1, lines 14-16; also page 1, paragraph 0003, lines 15-16); and distributing charging information (page 1, paragraph 0003, line 17; page 2, paragraph 0020, line 8).

Gemmer further suggests that the system can be GSM (page 2, paragraph 0019, line 5). Nevertheless, Gemmer fails to specifically disclose that the message distributes an access network charging identifier (for charging purposes) as defined by applicant.

The prior art admitted by applicant (simply “Admitted Prior Art”) disclosed on page 4, paragraph 0013 of the present disclosure under the Background of the Invention section and paragraphs 0039-0040 teaches that GPRS (a particular GSM service) typically requires a GGSN entity, a P-CSCF (PDF) entity, a GPRS charging identifier (GCID) sent from the GGSN to the P-CSCF (PDF) typically using COPS to enable charging. GPRS is a particular GSM service. GSM is 3G. Therefore, combinable with Gemmer’s teachings given that Gemmer teaches that the system can be GSM (page 2, paragraph 0019, line 5 of Gemmer).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enable Gemmer’s invention with a charging identifier or vector as required by GPRS because GPRS is a particular GSM service and Gemmer teaches that the system can be GSM; therefore, these would be particular requirement of a particular system as choice of engineering design.

Regarding **claim 4**, Gemmer discloses everything as applied above (see *claim 3*). Gemmer further suggests that the system can be GSM (page 2, paragraph 0019, line 5). Nevertheless, Gemmer fails to specifically disclose determining if charging information is provided during the establishment of said session and carrying out steps b) to d) only when it has been determined that the charging information has not been provided.

The prior art admitted by applicant (simply “Admitted Prior Art”) disclosed on page 5, paragraph 0015 of the present disclosure under the Background of the Invention section teaches that release 6 for third generation standard (3G) typically requires charging information not to be provided for a communication session. Consequently, there is no need to distribute charging information because it is not provided under 3G release 6. It should be noted that GSM is 3G. For that reason, Gemmer’s invention would be constructively enhanced and would positively benefit from 3G release 6 requirements.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determining if charging information is provided during the establishment of said session and carrying out steps b) to d) only when it has been determined that the charging information has not been provided in Gemmer in order to comply with release 6 for third generation standard as Gemmer’s invention would be constructively enhanced and would positively benefit from 3G release 6 requirements.

Regarding **claims 5-6**, Gemmer discloses everything as applied above (see *claim 1*). Gemmer further suggests that the system can be GSM (page 2, paragraph 0019, line 5). Nevertheless, Gemmer fails to specifically disclose using SIP for the session as claimed.

The prior art admitted by applicant (simply “Admitted Prior Art”) disclosed on pages 2-3, paragraphs 0008-0009 of the present disclosure under the Background of the Invention section teaches that SIP is typically required by newer releases for third generation standard (3G). SIP enables two-way telephone calls as well as multi-way conference sessions. It should be noted that Gemmer’s GSM is 3G and that Gemmer’s session/call is at least a two-way telephone call.

UMTS is based on GSM and is 3G. It implements SIP as claimed (see paragraphs 0008-0009 of Admitted Prior Art).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enable Gemmer's invention with SIP in order to comply with newer releases for 3G as it would be a particular requirement of a particular system.

Regarding **claims 8-18**, Gemmer discloses everything as applied above (see *claim 1*). However, Gemmer fails to specifically disclose GCID, a P-charging vector, a GGSN entity, a P-CSCF entity, a PDF function, COPS messages, and a user agent server as defined by applicant.

The prior art admitted by applicant (simply "Admitted Prior Art") disclosed on page 4, paragraph 0013 of the present disclosure under the Background of the Invention section and paragraphs 0039-0040 teaches that GPRS typically requires a GGSN entity, a P-CSCF (PDF) entity, a GPRS charging identifier (GCID) sent from the GGSN to the P-CSCF (PDF) typically using COPS to enable charging. GPRS is a particular GSM service. GSM is 3G. Therefore, combinable with Gemmer's teachings given that Gemmer teaches that the system can be GSM (page 2, paragraph 0019, line 5 of Gemmer). A user agent server as claimed is a particular requirement of 3G release 5 (see paragraph 0014 of the Admitted Prior Art).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enable Gemmer's invention with a charging identifier or vector, GCID or ICID, a P-charging vector, a GGSN entity, a P-CSCF entity, a PDF function, COPS messages, and a user agent server as required by GPRS because GPRS is a particular GSM service and Gemmer teaches that the system can be GSM; therefore, these would be particular requirement of a particular system as choice of engineering design.

However, Gemmer fails to specifically disclose a user agent server as claimed. Such is a particular requirement of 3G release 5 (see paragraph 0014 of the Admitted Prior Art)

Regarding **claim 19**, Gemmer and the Admitted Prior Art disclose everything as applied above (see *claim 5*). In addition, the Admitted Prior Art discloses charging information is sent in an INVITE message as claimed (via UPDATE message; paragraphs 0013-0014).

Regarding **claim 20**, Gemmer discloses everything as applied above (see *claim 1*). In addition, the establishing step comprises establishing a session wherein said node comprises user equipment (B or TEB) (see citations above).

As to **claims 21, 23, 25, 27, 29, and 31**, being corresponding claims to method claim 1; they are rejected for the same reasons explained above.

As to **claims 22, 24, 26, 28, 30, and 32**, being corresponding claims to method claim 3; they are rejected for the same reasons explained above.

Examiner's Remarks

11. As previously indicated, it has been noticed that the drawings of Gemmer (US Patent Application Publication 2004/0022233 A1) do not appear to match with Gemmer's written description. However, the rejection is based on the written description, not the drawings. The figures referenced in the Gemmer's written description are not of record. It has been noticed, however, that Gemmer finds adequate support in the priority document (PCT/DE01/03975 published as WO 02/34003) as it contains the same as in the US Patent Application Publication to Gemmer. For Applicant's convenience a copy of WO 02/34003 is being attached.

Response to Arguments

12. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

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13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

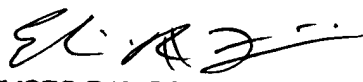
Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 571-272-7925. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid, can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ELISEO RAMOS-FELICIANO
PATENT EXAMINER

ERF/erf

January 20, 2006